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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,458	12/21/2001	Travis J. Parry	10019040-1	5480

7590 06/13/2007  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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PARK, CHAN S

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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06/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/029,458	<b>Applicant(s)</b> PARRY ET AL.	
	<b>Examiner</b> CHAN S. PARK	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5-8, 10, 11, 13-16 and 23-47 is/are pending in the application.

4a) Of the above claim(s) 3, 6-8, 10, 11, 15-16, 25-27, 29, 32, 34, 35, 37, 39, 41, 43 and 46 is/are withdrawn from consideration.

- 5) ☒ Claim(s) 1, 5, 13, 14, 23, 24, 28, 30, 38, 40, 42 and 44 is/are allowed.
- 6) ☒ Claim(s) 31 and 36 is/are rejected.
- 7) ☒ Claim(s) 33, 45 and 47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN  
PRIMARY EXAMINER

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. **Claims 3, 6-8, 10, 11, 15, 16, 25-27, 29, 32, 34, 35, 39, 41, 43, 45 and 46** are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species I and III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/21/07.

Furthermore, it is noted that **claim 37**, which the applicant grouped in Species II, should clearly be grouped with Species III. Therefore, claim 37 is also withdrawn from further consideration.

The examiner further notes that **claim 45** can also be examined together with elected Species II. Therefore, claim 45 is not withdrawn from further consideration.

2. In response to the applicant's argument regarding the restriction requirement, the applicant traverses the restriction by pointing out MPEP § 803. This is not found persuasive. The Examiner notes that search and examination of all claims cannot be made without "serious burden" on the Examiner. Upon thorough search and examination for elected Species II, the Examiner concludes that the closest prior art (U.S. Patent No. 7,102,779) applicable to one invention (elected Species II) is not applicable to another invention (non-elected Species I and III). Therefore, further search is required for the non-elected species and it, thus, puts serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

***Response to Arguments***

3. Applicant's arguments, see pages 12-19, filed on 11/28/06, with respect to **claims 1, 5, 13, 14, 23, 24, 28, 30, 31, 33 and 36** under 35 U.S.C. § 112 and 103(a) have been fully considered and are persuasive. The rejections have been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made for **claims 31 and 36** in view of Lester et al. U.S. Patent No. 7,102,779 (hereinafter Lester).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 31 and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Refer to page 53 of the Interim Guideline. The examiner suggests using the term -- a computer program -- instead of "a program".

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 recites the limitation "the portable computing device". There is insufficient antecedent basis for this limitation in the claim. Perhaps, the term -- by a portable computing device, -- should be inserted after "receive" in line 3, claim 36.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 36 is rejected under 35 U.S.C. 102(e) as being anticipated by Lester

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. With respect to claim 36, Lester discloses a computer-readable medium that stores a computer program that facilitates secure printing (abstract), comprising:

logic configured to receive an untranslated document from a nearby printing device (col. 2, lines 58-61);

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logic configured to translate (by the buddy printer) the document into a print ready format (col. 2, lines 65-67 & col. 6, lines 53-61); and

logic configured to facilitate transmission of the translated document back to the printing device so that the printing device can generate a hard copy of the document (col. 8, lines 57-60).

***Allowable Subject Matter***

7. Claims **1, 5, 13, 14, 23, 24, 28 and 30, 38, 40, 42 and 44** are allowed.
8. Claims 31, 33 and 45 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.
9. Claim 47 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

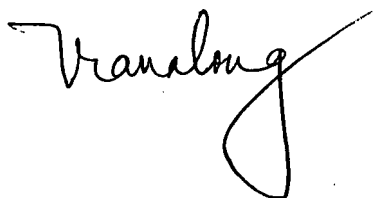
**Contact Information**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

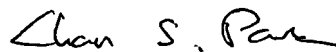
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DOUGLAS Q. TRAN  
PRIMARY EXAMINER



Chan S. Park  
Examiner  
Art Unit 2625



csp  
June 8, 2007